

REMARKS / ARGUMENTS

This application is believed to be in condition for allowance because the claims are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasoning for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject patent application.

1.0 Summary of Applicant Initiated Examiner Interview of March 25, 2004:

An applicant initiated interview was conducted on March 25, 2004, between attorney for Applicant, Mr. Mark Watson, and the Examiner of record, Mr. Saleh Najar. Applicant explained that Hachamovitch et al., U.S. Patent 6,377,965 (hereinafter "**Hach**"), failed to teach dynamically tracking a data store and analyzing and extracting information from files within the data store. Applicant also explained that **Hach** failed to teach any process whereby files such as word processor documents, spreadsheet files, and presentation files (i.e., the user's "data store") could be analyzed to locate and extract contact information from within such files.

Applicant noted that the Office Action of February 23, 2004 suggested that **Hach** provided a "word completion system" which "may be deployed within an individual application such as a word processor program or email program and alternately may be deployed within an operating system or an application independence basis such as spreadsheet program or personal calendar program." Applicant explained that the suggested ability of **Hach** to operate on an application independent basis from within various applications served only to **provide** completion information from **within those applications**, while failing to teach or in any way suggest a method for actually **analyzing the files themselves** (i.e., word processor files, spreadsheet files, and presentation files) for the purpose of extracting the contact information, and then "adding the contact information to the dynamic list" as described and claimed by the Applicant.

Applicant reiterated that the various independent claims were directed to a system and method for **extracting contact information** from various specifically enumerated file types for use in a real-time auto-completion type system and method. Applicant contrasted this claimed system to the **Hach** system for populating its automatic completion data (see column 7, and columns 10-11), which included manual user input, and reading operating system parameters (including date, time, file names, and registered users). Applicant further explained that while **Hach** uses **existing** structured data fields, such as email address books to directly provide completion information, that information does not appear to be extracted for use in actually **populating** a suggestion list for later use in the word completion system.

Examiner requested that the arguments presented during the Examiner Interview be submitted in a formal response that those arguments could be given further consideration. No agreement was reached as to the allowability of the independent claims.

2.0 Rejections Under 35 U.S.C. §103(a):

In the Office Action of February 23, 2004, claims 1-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hachamovitch et al., U.S. Patent 6,377,965 (hereinafter "**Hach**") further in view of Creswell et al., U.S. Patent 6,564,264 (hereinafter "**Creswell**").

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art**

reference (or references when combined) must teach or suggest all the claim limitations.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

2.1 Rejection of Claims 1-22:

In general, the Office Action rejected independent claim 1 under 35 U.S.C. §103(a) based on the rationale that ***Hach*** discloses the Applicants' invention substantially as claimed, but that "Hach does not explicitly teach the limitation wherein the data store of items comprises one or more of previously sent email and previously received email." ***Creswell*** is then offered by the Office Action as teaching this feature.

In particular, with respect to the Applicants' claimed element of "dynamically tracking a data store of items comprising a plurality of electronic documents..." the Office Action offers col. 7-8 as teaching that "***Hach*** discloses that suggestion lists are defined based on dynamic parameters maintained by the computer system including structured data field entries, e-mail address book and that the ***word completion system may be deployed within an individual application program...***" (emphasis added).

However, the Applicant would first like to note that in the previous Office of September 3, 2003, the Office Action admitted that "Hach does not explicitly teach the limitation of 'dynamically tracking the data store'," (see page 3 of the Office Action of

September 3, 2003). The Applicants agree with this interpretation of the **Hach** reference as originally offered by the first Office Action.

For example, as explained by the Applicants during the Examiner Interview of March 25, 2004, and as suggested by the Office Action of February 23, 2004, **Hach** provides a "word completion system" which "**may be deployed within an individual application** such as a word processor program or email program and alternately may be deployed within an operating system or an application independence basis such as spread sheet program or personal calendar program." The Applicants believe that ability of **Hach** to operate on an "application independent basis" from within various applications serves only to **provide** completion information, and in one embodiment, the ability to manually update "suggestion lists," from **within those applications**, while failing to teach or in any way suggest a method for actually **tracking** items within a data store (i.e., computer files such as word processor files, spreadsheet files, and presentation files) for **analyzing the contents of those files** for the purpose of extracting the contact information from the contents of those files, as described and claimed by the Applicant.

Next, the Office Action continued by suggesting that **Hach** discloses "analyzing and extracting contact information from items within the data store" and "adding the contact information to the suggestion list..." The Office Action supports this suggestion by explaining that "Hach discloses that suggestion lists are defined based on dynamic parameters maintained by the computer system including structured data field entries, e-mail address book, word processor program, email program, spreadsheet program and personal calendar program..."

However, as explained by **Hach** in col. 7, lines 22-24, these "**dynamic parameters**" are simply parameters maintained by the operating system such as time, date, and registered users. Further, the "structured data fields" noted by the Office Action appears to refer to existing information such as "email address books" (see, for example, col. 7, lines 41-46) which are simply **used** to directly provide completion information from within existing applications rather than being used to actually **populate** a dynamic list of contact

information by analyzing the **contents** of particular file types, extracting contact information from the content of those files, and then “**adding the contact information to the dynamic list.**” In other words, the Applicant actually creates and populates a dynamic suggestion list for later use, while **Hach** merely provides completion information from existing structured data fields or dynamic system parameters for direct insertion into an application.

Further, it should be noted that the Applicant has amended independent claim 1, to make it clearer that the contact information is extracted from the actual **contents** of particular file types, including one or more of computer files such as **word processor files, spreadsheet files, and presentation files.** It should be clear that **extracting contact information** from various specifically enumerated file types for use in populating a dynamic list of contact information is not disclosed by the **Hach** system for providing its automatic completion data (see column 7, and columns 10-11), which includes manual user input and reading operating system parameters (including date, time, file names, and registered users). Further, it also appears that **Hach's** use of **existing** structured data fields, such as email address books, to provide completion information from within an existing application, fails to disclose any embodiment where that contact information is somehow extracted for use in actually **populating** a suggestion list for use in the word completion system.

As noted above, the Office Action suggests that **Creswell** discloses automatically updating a database based on incoming and outgoing mail messages. The Office Action offers Figs. 1-3 and col. 3-4 of the **Creswell** reference in support of this contention. The Office Action then suggests that it would have been obvious to one skilled in the art to modify **Hach** by “dynamically tracking a data store (database) as taught by Creswell to update a contact list at a client computer.”

However, as noted above, independent claim 1 has been amended to stipulate that the contact information is extracted from the actual **contents** of particular file types, including one or more of computer files such as **word processor files, spreadsheet files,**

and ***presentation files***. It should be clear that ***extracting contact information*** from various specifically enumerated file types for use in populating a dynamic list of contact information is not equivalent to using email addresses derived from sent and received email messages as disclosed by ***Creswell***.

In particular, as described by the Office Action, ***Creswell*** discloses automatically updating a database based on ***incoming and outgoing mail messages***. While ***Creswell*** does monitor such messages dynamically for the purpose of updating address database, ***Creswell*** fails completely to disclose any capability to analyze electronic files other than contact databases and email messages for extracting contact information. In fact, ***Creswell*** does not disclose a capability to analyze and extract contact information from the ***contents*** of items. Specifically, ***Creswell*** offers no teaching or suggestion regarding a system or method for automatically analyzing and extracting contact information from the actual contents of electronic application files, which include word processor files such as Microsoft® Word documents, presentation files such as Microsoft® PowerPoint® files, and spreadsheet files such as Microsoft® Excel files. In fact, ***Creswell*** does not appear to suggest that contact information can be extracted from an analysis of electronic files other than email messages or contact databases.

Therefore, in view of the preceding discussion, the modification of ***Hach*** by adding the ***Creswell*** capability to dynamically update a database based on incoming and outgoing mail messages fails to disclose the Applicants claimed elements of “***dynamically tracking a data store of items comprising a plurality of electronic documents including one or more of word processor files, spreadsheet files, and presentation files***” and “***analyzing and extracting contact information from the contents of items within the data store***”.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious

language of independent claim 1, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 1, and thus of dependent claims 2-22 under 35 U.S.C. §103(a) over **Hach** further in view of **Creswell** in view of the non-obviousness of the above-cited language of claim 1, as amended.

1.2 Rejection of Claims 23-28:

The Office Action rejected independent claim 23 on the same basis as claim 1. In particular, the Office Action suggested that “[c]laims 23-32 do not teach or define any new limitations above claims 1-22 and therefore are rejected under similar reasons.”

However, in view of the discussion provided above in Section 1.1, it is clear that neither **Hach** nor **Creswell**, nor any possible combination thereof, provides any disclosure or teaching directed towards “dynamically tracking a data store and **analyzing and extracting contact information from the contents of items within the data store**, the items within the data store comprising a plurality of electronic documents including one or more of **word processor files, spreadsheet files, and presentation files**” (emphasis added) as described and claimed by the Applicants.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 23, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 23, and thus of dependent claims 24-28 under 35 U.S.C. §103(a) over **Hach** further in view of **Creswell** in view of the non-obviousness of the above-cited language of claim 23, as amended.

1.3 Rejection of Claims 29-32:

The Office Action rejected independent claim 29 on the same basis as claim 1. In particular, the Office Action suggested that “[c]laims 23-32 do not teach or define any new limitations above claims 1-22 and therefore are rejected under similar reasons.”

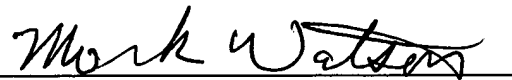
However, in view of the discussion provided above in Section 1.1, it is clear that neither **Hach** nor **Creswell**, nor any possible combination thereof, provides any disclosure or teaching directed towards “an extract module that **analyzes and extracts contact information from the contents of items within a data store** to dynamically track entries, said items within the data store comprising a plurality of electronic documents including one or more of **word processor files, spreadsheet files, and presentation files**” (emphasis added) as described and claimed by the Applicants.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 29, as cited above. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 29, and thus of dependent claims 30-32 under 35 U.S.C. §103(a) over **Hach** further in view of **Creswell** in view of the non-obviousness of the above-cited language of claim 29, as amended.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-32, as amended are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-32 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

A handwritten signature in cursive script, reading "Mark A. Watson", is written over a horizontal line.

Mark A. Watson
Registration No. 41,370
Attorney for Applicants

Lyon & Harr, LLP
300 Esplanade Drive, Suite 800
Oxnard, California 93036
(805) 278-8855